

REMARKS

I. Allowed and Allowable Claims

Applicants appreciate the Examiner's allowance of Claims 31-46 and the indication of allowability of Claims 5-6, 8-9, 20-21, and 23-24. In accordance with the indication of allowability, Applicants have amended Claims 5, 8, 20, and 23 to write those claims in independent form. Also, Applicants have added new Claims 113-115, which are similar to allowed Claim 5, but recite a file allocation table, a root directory, and a partition boot record, respectively, instead of a master boot record. Applicants submit that, like Claim 5, new Claims 113-115 are allowable.

II. Amendment to Dependent Claims 83-86 and 89

Applicants have amended dependent Claims 83-86 and 89 to correct typographical errors.

III. Double Patenting Rejection

Claim 92 was provisionally rejected under the judicially-created doctrine of obviousness-type double patenting in view of Claim 21 in copending U.S. patent application serial number 09/877,691. In response to this provisional rejection, Applicants submit herewith the appropriate terminal disclaimer and fee. In view of these submissions, Applicants respectfully request that the provisional obviousness-type double patenting rejection be removed.

IV. 35 U.S.C. § 112, Second Paragraph, Rejections

Claims 74-80 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, it was asserted that there was insufficient antecedent basis for the recitations of "a memory device" and "a write-many file system" in lines 3-4 of independent Claim 74. Claims 75-80 were rejected due to their dependence on independent Claim 74.

Applicants respectfully traverse these rejections. The use of the article “a” in the recited phrases “a memory device” and “a write-many file system” establishes antecedent basis for these terms. Accordingly, Applicants respectfully request that the 35 U.S.C. § 112, second paragraph, rejections be removed.

V. Independent Claims 1, 15, 64, and 92

Independent Claims 1, 15, 64, and 92 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,832,263 to Hansen et al. under the assertion that Hansen et al. teaches storing file system structures in a write-once memory device. Applicants respectfully traverse these rejections because what is asserted to be a “file system structure” in Hansen et al. is stored in a *write-many* memory device — *not* a *write-once* memory device, as recited in the claims.¹

Hansen et al. teaches a non-modifiable store (NMS), which is a *write-once* memory device (such as a CD-ROM), and a *modifiable* tracking store (TS), which is a *write-many* memory device (such as a floppy diskette). In operation, a write operation to modify a file in the non-modifiable store (NMS) is intercepted and remapped to the modifiable tracking store (TS). In this way, when a modification is to be made to a file stored in the non-modifiable store (NMS), the modification is stored instead in the modifiable tracking store (TS) along with a pointer to a location in the modifiable tracking store (TS) that stores the modification. The pointer is updated as further modifications take place.

¹ In rejecting another claim in the Office Action, the Examiner admitted that Hansen et al. stores what is asserted to be a file system structure in a *write-many* memory device: “Hansen discloses . . . storing a file system structures [sic] of a write-many file system in a *write-many* memory array of the memory device.” Page 5, paragraph 7 (emphasis added).

In contrast, independent Claims 1, 15, 64, and 92 require a file system structure (and, in some claims, also a pointer) to be stored in a ***write-once*** memory device — ***not*** a ***write-many*** memory device. Independent Claim 1 recites storing first and second sets of file system structures and a pointer in a ***write-once*** memory device, and independent Claim 15 recites a ***write-once*** memory device comprising first and second sets of file system structures and a pointer. Further, independent Claim 64 recites storing first and second sets of file system structures in a ***write-once*** memory device, and independent Claim 92 recites storing a file system structure in a ***write-once*** memory device. Because each of these independent claims recites storing a file system structure (and, in some claims, a pointer) in a ***write-once*** memory device and Hansen et al. only teaches storing what is purported to be file system structures in a ***write-many*** memory device, Applicants respectfully request that the rejections against independent Claims 1, 15, 64, and 92 and their dependent claims be removed.²

VI. Independent Claims 47 and 54

Like independent Claims 1, 15, 64, and 92, independent Claim 47 recites storing file system structures in a ***write-once*** memory device, and amended independent Claim 54 recites preventing the overwriting of a file system structure in a write-once memory device by redirecting data to another part of the ***write-once*** memory device. Also like independent Claims 1, 15, 64, and 92, independent Claims 47 and 54 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hansen et al. under the assertion that Hansen et al. teaches storing file system structures in a write-once memory device. However, as discussed above and as admitted by the Examiner in another part of the Office Action, Hansen et al. stores what is asserted to be a file

² Independent Claims 1, 15, 64, and 92 and their dependent claims recite additional elements not shown in Hansen et al., alone or as modified. Applicants expressly reserve the right to argue these additional grounds of patentability at a later date, if necessary.

system structure in a ***write-many*** memory device — ***not a write-once*** memory device as recited in independent Claims 47 and 54. For this reason, Hansen et al., alone or as modified in the Office Action, is insufficient to render independent Claims 47 and 54 unpatentable. Accordingly, Applicants respectfully request that the rejections against independent Claims 47 and 54 and their dependent claims be withdrawn.³

VII. Independent Claims 66 and 74

Independent Claims 66 and 74 were rejected under 35 U.S.C. § 102(b) as being anticipated by Hansen et al. Applicants have amended Claims 66 and 74 to clarify the invention being claimed. Specifically, these claims now recite that the memory device is a ***handheld*** memory device (such as a memory card or stick, as recited in new dependent Claims 111-112) that comprises an electrical connector operative to couple with a mating electrical connector of a data storage device. The handheld memory device comprises both a write-once memory array and a write-many memory array.

In contrast to independent Claims 66 and 74, which recite that the write-once memory array and the write-many memory array are contained in a handheld memory device, Hansen et al. teaches a system that uses two separate memory devices — one that is write-once (the non-modifiable store (NMS)) and one that is write-many (the modifiable tracking store (TS)). For example, Hansen et al. teaches that the non-modifiable store (NMS) can be a CD-ROM, and the modifiable tracking store (TS) can be a floppy diskette. Clearly, a CD-ROM and a floppy diskette are not components that fit in a handheld memory device (such as a memory card or stick) with an electrical connector that mates with an electrical connector of a data storage

³ The dependent claims recite additional elements not shown in the proposed combination. Applicants expressly reserve the right to argue these additional grounds of patentability at a later date, if necessary.

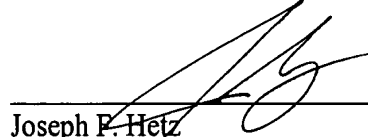
device. Because Hansen et al. does not teach the elements added to independent Claims 66 and 74, Applicants respectfully request withdrawal of the rejections against these claims and their dependent claims.⁴

VIII. Conclusion

In view of the foregoing amendments and remarks, Applicants submit that this application is in condition for allowance. Reconsideration is respectfully requested. If there are any questions concerning this Amendment, the Examiner is asked to phone the undersigned attorney at (312) 321-4719.

Dated: August 6, 2004

Respectfully submitted,



Joseph F. Hetz
Reg. No. 41,070
Attorney for Applicants

BRINKS HOFER
GILSON & LIONE
P.O. Box 10395
Chicago, Illinois 60610
(312) 321-4719

⁴ The dependent claims recite additional elements not shown in Hansen et al. Applicants expressly reserve the right to argue these additional grounds of patentability at a later date, if necessary.